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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,117	01/08/2002	Donald F. DePalma	CRD0918	4482

27777 7590 01/14/2004  
PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

MILLER, CHERYL L

ART UNIT PAPER NUMBER

3738

DATE MAILED: 01/14/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/041,117

Applicant(s)

DEPALMA ET AL.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2003 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 17-22 been renumbered 19-24.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant has positively claimed a portion of the body,

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which is non-statutory subject matter. In claims 8 and 24, applicant has claimed the aneurysm as part of the system, "a channel that bypasses the aneurysm", and "that is disposed within the aneurysm". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 7, and 8 recite the limitation "the prosthesis" in line 2 of each claim. There is insufficient antecedent basis for this limitation in the claims. Applicant should recite whether the prosthesis is the first prosthesis or second prosthesis in the claims. Claim 8 depends upon claim 7 and inherits all problems with the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-9, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Pavcnik et al. (USPN 6,325,819 B1, cited by applicant in IDS). Referring to claims 1 and 9, Pavcnik discloses a system for bypassing an aneurysm comprising a first prosthesis (1) and at least two second prostheses (2, 3) communicating with the first prosthesis (1), the first prosthesis (1) comprising a proximal end (top of 1), distal end (bottom of 1), a conduit defining a single

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fluid flow path (see fig. 10), and a compressible gasket (5') positioned in an interior of the first prosthesis (1) and conduit proximate to the distal end (fig. 10; col. 3, lines 18-27), the gasket (5') including apertures (10, 11) for receiving the two second prostheses (2, 3) to create a fluid flow path.

Referring to claim 2, Pavcnik discloses the first prosthesis (1) comprising a stent (4) and a graft material (material making up gasket 5') communicating with the stent (4).

Referring to claim 3, Pavcnik discloses the stent (4) and graft material (material making up gasket 5') defining a fluid flow path (conduit of 1<sup>st</sup> prosthesis above 5', 10, or 11) through the prosthesis.

Referring to claim 5, Pavcnik discloses a gasket (5') configured to receive two second (2, 3) prostheses.

Referring to claims 6-8, Pavcnik discloses second prostheses comprising a stent and graft material communicating with the stent (col. 5 line 65-col. 6 line 2), which define a fluid flow path through the prosthesis bypassing an aneurysm (fig. 10).

Referring to claim 19, Pavcnik discloses a gasket (5') integrally formed with the graft material (they are integral, the graft material makes up the gasket).

Referring to claim 20, Pavcnik discloses the gasket comprising an open cell foam material (polyurethane, polyethylene, PTFE, col. 3, lines 15-20, materials applicants have disclosed in their specification as being open cell foams well known in the art on pg. 21, lines 9-12).

Referring to claim 21, Pavcnik discloses a gasket (5') substantially impervious to fluid (col. 5, lines 15-16) creating a seal between the first and second prostheses (fig. 10).

Referring to claims 22-23, Pavcnik discloses the second prostheses (2, 3) matingly engaged with the gasket (5') at a position proximate to the distal end or at the distal end of the first prosthesis (fig.10).

Referring to claim 24, Pavcnik discloses a first prosthesis (1) sufficient length to extend from a healthy region of an infrarenal neck into an aneurysm and the gasket (5') engaged with the second prosthesis (2, 3) at a position along the first prosthesis (1) that is disposed within the aneurysm (fig.10).

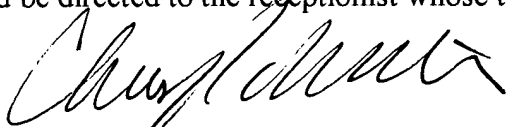
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Cheryl Miller



BRUCE SNOW  
PRIMARY EXAMINER